

Serial No. 10/647,406  
Filed: August 25, 2003  
Page 4 of 9

Examiner: William E. Tapolcai  
Group Art Unit: 3744

### **Remarks/Arguments**

Claims 1-21 were in the application as filed. Claims 1-5 and 8-9 were previously canceled from the application without prejudice. Pursuant to a restriction requirement, claims 6, 7, 12-18, and 22-35 have been canceled without prejudice.

Claims 10, 11, and 19-21 stand rejected. In this Amendment and Response, claims 10 and 19-21 have been canceled without prejudice. Claim 11 has been amended to depend from new independent claim 36. Claims 36-47 have been added.

No new matter has been added by the foregoing amendments, full support therefor being shown in the drawings and specification as filed. All claims remaining in the application are believed to now be in condition for allowance.

Further examination and reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

### **Rejections under 35 U.S.C. §103(a)**

Claims 10, 11, and 19-21 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 5,265,437 to Saperstein et al. in view of U.S. Patent No. 3,850,006 to Redfern et al. The rejection is traversed.

Claims 10 and 19-21 have been canceled without prejudice, and claim 11 has been amended to depend from new independent claim 36. Thus, the rejection of claims 10, 11, and 19-21 is moot.

Claim 36 is essentially claim 10 amended to more particularly and distinctly claim the subject matter that Applicant believes to be his invention. Applicant has also added new claims 37-47 to capture additional subject matter disclosed in the specification. Claims 36-47 are allowable because claim 36 is patentable over Saperstein '437 in view of Redfern '006.

Initially, the asserted combination fails to meet the *prima facie* standard for combining references under 35 U.S.C. §103(a), and is therefore improper. Saperstein '437 discloses a truck having a first refrigeration circuit 38-42, 48, 50, 58, 60, 63 located in the engine compartment, thermally coupled to a second refrigeration circuit 65-78, 82-90 located in the engine

Serial No. 10/647,406  
Filed: August 25, 2003  
Page 5 of 9

Examiner: William E. Tapolcai  
Group Art Unit: 3744

compartment and extending from the engine compartment into the truck cab. The second refrigeration circuit is used to deliver cooled air to the cab and a cargo or sleeping compartment. The second refrigeration circuit is also used to cool fluid, such as transmission oil, engine oil, or turbocharger intercooler fluid in an exothermal mechanical device. *Col. 7, ln. 29-35.*

Redfern '006 discloses a conventional vehicle air conditioning system utilizing a conventional cooling fluid in which a cooling container 10 is fluidly connected to the air conditioning system to thereby utilize the cooling fluid to cool the container 10. The container comprises a cabinet 30 enclosing a cooling unit 12 comprising a coil 50 enclosed in a tank 40 filled with a liquid disposed inside the cabinet 30. A pair of couplers 54 in the wall of the cabinet 30 can be fluidly connected through mating couplers 68 to the vehicle air conditioning system.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the relevant art would lead that individual to combine the relevant teachings of the references. The Examiner cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988). When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight. *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. See, also, *Manual of Patent Examining Procedure* §706.02(j).

Serial No. 10/647,406  
Filed: August 25, 2003  
Page 6 of 9

Examiner: William E. Tapolcai  
Group Art Unit: 3744

Section 706.02(j) of the Manual of Patent Examining Procedure is explicit as to what must be done to support a rejection under 35 U.S.C. §103(a).

“After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. ‘To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.’ *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).”

Serial No. 10/647,406  
Filed: August 25, 2003  
Page 7 of 9

Examiner: William E. Tapolcai  
Group Art Unit: 3744

Saperstein '437 is directed toward a cooling system for a truck cab and power train fluids that minimizes the volume of atmospheric ozone-depleting compounds in the cooling system. Redfern '006 is directed toward a vehicle air conditioning system incorporating a cooling chamber which utilizes the refrigerant in the vehicle air conditioning system. The refrigerant lines in the cooling chamber can be quickly connected and disconnected from the refrigerant lines of the air conditioning system through quick-connect fitting. The Examiner has not identified any teaching, suggestion, or motivation in either Saperstein '437 or Redfern '006 for combining these two references, each of which is directed toward an entirely different technical problem, as is required to meet the *prima facie* standard. The Examiner has provided no explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to modify the device in either reference with the device disclosed in the other. The Examiner has not identified the relevant teachings of the prior art relied upon to make the asserted combination. Because the combination is improper, the claims are patentable.

Even if the combination were proper, the combination would not reach Applicant's claimed invention. Claim 36 in relevant part requires a docking station remotely positioned from the primary heat exchanger and fluidly disposed in the secondary cooling circuit, a container removably coupled to the docking station, and a secondary heat exchanger comprising part of the docking station which transfers heat between the container and the secondary cooling circuit to cool the container.

Combining Saperstein '437 and Redfern '006 would disclose a primary cooling circuit containing a CFC, HFC, HCFC, or HC refrigerant, a secondary cooling circuit containing a glycol-based coolant, and a heat exchanger (Saperstein '437), a pair of quick-connect fittings (Redfern '006), a container removably coupled to the primary cooling circuit through the quick-connect fittings (Redfern '006), with the container having an internal heat exchanger, but no connection of the container to the secondary cooling circuit and no secondary heat exchanger comprising part of a docking station.

Serial No. 10/647,406  
Filed: August 25, 2003  
Page 8 of 9

Examiner: William E. Tapolcai  
Group Art Unit: 3744

In other words, the combination discloses a portable container with an internal heat exchanger that can be coupled to the primary cooling circuit through quick-connect fittings. It does not disclose the claimed concept of a remote docking station comprising a heat exchanger supplied by the secondary cooling circuit and to which a container can be removably docked. The claimed invention separates the coolant of the second circuit from the container. That is, the coolant of the second circuit does not have to pass into the container, unlike the combination, which makes the claimed invention more likely to avoid the accidental spilling or loss of the coolant. Therefore, claim 36 is patentable over Saperstein '437 in view of Redfern '006, and is allowable.

Because claims 11 and 37-46 depend from claim 36, these claims are likewise allowable. Furthermore, claim 42 is patentable since the combination does not disclose a non-toxic coolant. Claim 43 is patentable since the combination does not disclose at least two docking stations remotely positioned from the primary heat exchanger and from each other, and fluidly disposed in the secondary cooling circuit, and a container associated with each docking station, the at least two docking stations each comprising a secondary heat exchanger which transfers heat between the container and the secondary cooling circuit to cool the container. Claim 45 is patentable since the combination does not disclose cooled air circulated over the container to cool the container. Claims 46 and 47 are patentable since the combination does not disclose a tube-in-tube heat exchanger or a fin-tube heat exchanger having portions of the primary cooling circuit and the secondary cooling circuit imbedded in the fins of the fin-tube heat exchanger.

Applicant requests the withdrawal of the rejection of claims 10, 11, and 19-21 and the allowance of claims 11 and 36-46.

### **Conclusion**

For the reasons discussed above, all claims remaining in the application are allowable over the prior art. Early notification of allowability is respectfully requested.

Serial No. 10/647,406  
Filed: August 25, 2003  
Page 9 of 9

Examiner: William E. Tapolcai  
Group Art Unit: 3744

Applicant respectfully requests an Advisory Action be issued in this case. If there are any remaining issues which the Examiner believes may be resolved in an interview, the Examiner is respectfully invited to contact the undersigned.

Respectfully submitted,

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